

R E M A R K S

The Examiner is respectfully requested to acknowledge the Information Disclosure Statement which was filed on January 30, 2004.

This Amendment is in response to the Office Action that was mailed on February 18, 2004. Applicants again confirm the election of Group I (previously, claims 1-4) and of the species 4-dodecyloxycarbonyl-N-hydroxyphthalimide within Group I. New claim 10 corresponds to original claim 3. New claims 11-14 are drawn to specific catalyst compounds disclosed on page 19 of the specification. No new matter has been introduced. Claims 1-4 and 10-14 are in the application. It is respectfully submitted that all of the claims now present in the application could most efficiently be examined together herein.

Claims 3 and 4 were previously rejected under 35 U.S.C. §102(a) as being anticipated by *J. Org. Chem.* 66:7889-7891 (Sawatari), and claims 3 and 4 were previously rejected under 35 U.S.C. §103(a) as being unpatentable over Sawatari in view of US 6,232,258 B1 or JP 08-38909. As pointed out in the Amendment filed November 26, 2003, the present claims are entitled to the benefit under 35 U.S.C. §119 of a date of 9 March 2001, which antedates the Sawatari publication. Therefore, the rejections based upon the Sawatari publication should be withdrawn.

Claims 3 and 4 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Electrochimica Acta* 44:385-393 (Gorgy) in view of US 6,232,258 B1 (Ishii). Claims 3 and 4 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gorgy in view of JP 08-38909 (also Ishii). Applicants rely upon their discussion of the rejections set forth in the Amendment of November 26, 2003.

SUMMARY OF ARGUMENTS. The catalysts of the present invention have low Fedors solubility parameters, in many case less than or equal to 26 (MPa)^{1/2}. The presently claimed catalyst compounds are highly soluble even in the absence of solvents or in the presence of low polarity solvents. Accordingly, the presently claimed catalysts provide target compounds in good yields. In contrast, the high hydrophilicity imide compounds of the references do not provide target compounds in effective yields. It is respectfully submitted that the amount of picking and choosing within the disclosures of the references that the Examiner has done is inconsistent with the statutory standard of "obvious at the time the invention was made to a person having ordinary skill in the art". In any case, the references even combined are not suggestive of the dramatic improvements in yields provided by the present invention. Therefore, withdrawal of the rejections over Gorgy in view of US 6,232,258 B1 and JP 08-38909 is respectfully solicited.

Claims 3 and 4 were rejected on the ground of obviousness-type double patenting over claims 4 and 7-9 of US 6,232,258 B1. As pointed out in the Amendment filed November 26, 2003, common ownership does not exist in the present situation, because US 6,232,258 B1 is owned by the entity 'Daicel Chemical Industries, Ltd. along with Yasutaka Ishii', while the present application is owned by the different entity 'Daicel Chemical Industries, Ltd'. See MPEP 706.02(l)(1). Therefore the double patenting rejection is not sustainable.

Should there be any outstanding issues that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher (Reg. No. 28,781) at (703) 205-8008.

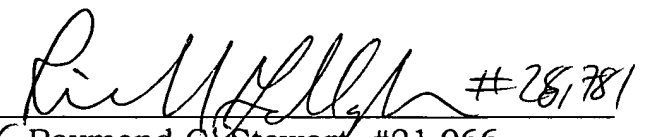
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment

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to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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